

REMARKS

At the time of the Office Action dated December 14, 2005, claims 1-17 were pending in this application. Of those claims, claims 9-14 have been rejected. Applicants acknowledge, with appreciation, the Examiner's allowance of claims 1-8 and 15-17. Claims 11-14 have been amended. Specifically, claim 11 has been amended to be placed in independent form, and claims 12-14 have been amended to depend from claim 11. Applicants submit that the present Amendment does not generate any new matter issue.

**CLAIMS 9-10 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY
FELLENSTEIN ET AL., U.S. PATENT NO. 6,747,555 (HEREINAFTER FELLENSTEIN)**

On page 2 of the Office Action, the Examiner asserted that Fellenstein discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference.¹ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.² This burden has not been met.

With regard to independent claim 9, the Examiner asserted the following:

Regarding claim 9: Fellenstein et al. discloses a tracking system comprising a radio frequency identification (RFID) tag affixed to a personal article (28-31); a plurality of RFID tracking processors (18, 19) coupled to a corresponding plurality of pervasive devices managed by

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

² Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., *supra*.

a corresponding plurality of subscribers; and, a central command (40) communicatively coupled to said pervasive devices (Fig. 1; col. 3, lines 21-62).

The Examiner has specifically identified those features in Fellenstein that allegedly corresponding to the claimed personal article (i.e., ERS remote devices 28-31), RFID tracking processors (i.e., remote sensors 18, 19), and a central command (i.e., display unit 40). However, it is notable that the Examiner has failed to specifically identify those features in Fellenstein that allegedly correspond to the claimed "a corresponding plurality of pervasive devices managed by a corresponding plurality of subscribers" to which the plurality of RFID tracking processors are coupled. Although the Examiner also cited Fig. 1 and column 3, lines 21-62 of Fellenstein for support, upon review this disclosure, Applicants are unable to determine where Fellenstein teaches these claimed features. In fact, Fig. 1 of Fellenstein discloses no other features besides those already identified by the Examiner.

The above argued differences between the system defined in independent claim 9 and the disclosure of Fellenstein undermine the factual determination that Fellenstein identically describes the claimed invention within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully submit that the imposed rejection of claims 9 and 10 under 35 U.S.C. § 102 for anticipation based upon Fellenstein is not factually viable and, hence, solicit withdrawal thereof.

**CLAIMS 11-14 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
FELLENSTEIN**

On pages 6 and 7 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Fellenstein to arrive at the claimed invention. This rejection is respectfully traversed.

Although Applicants disagree that the claimed invention is obvious based upon Fellenstein, to expedite prosecution of the Application, Applicants submit that the reference to Fellenstein cannot be properly applied against the present Application under 35 U.S.C. § 103. As discussed in M.P.E.P. § 2146, a reference that qualifies as "prior art" only under 35 U.S.C. § 102(e) cannot be considered when determining whether an invention is obvious under 35 U.S.C. § 103, provided the prior art and the claimed invention were commonly owned at the time of the invention. See M.P.E.P. § 706.02(l).

**Application No. 10/663,639 (the present application) and
U.S. Patent No. 6,747,555 (Fellenstein) were, at the time the
invention was made, commonly owned by International Business
Machines Corporation**

Thus, under 35 U.S.C. § 103(c), the reference to Fellenstein cannot be considered by the Examiner when determining whether Applicants' invention is obvious under 35 U.S.C. § 103. Applicants, therefore, respectfully submit that the imposed rejection of claims 11-14 under 35 U.S.C. § 103 for obviousness based upon Fellenstein is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing

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remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,



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